APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,312	06/21/2005	David A. Eves	A008-7008US0	1622

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EXAMINER
YEN, ERIC L

ART UNIT	PAPER NUMBER
2626	

NOTIFICATION DATE	DELIVERY MODE
04/09/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 8-10* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-4, 8-10* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   In response to the Advisory Action mailed 11/24/08, applicant has submitted an amendment filed 2/17/09.

Claims 1-2, 4, and 9, have been amended. Claims 5-7, and 11-12, have been cancelled.

Response to Arguments

1.   Applicant's arguments filed 2/17/09 have been fully considered but they are not persuasive.

Applicant's remarks content that Claims 1-12 are in condition for allowance and should be passed to issue (Amendment, page 6), however Claims 5-7 and 11-12 are labeled as cancelled. Therefore, the examiner has interpreted that the pending claims are not 1-12 but rather 1-4 and 8-10.

Applicant argues that the combined teachings of Davis and Levy would not disclose the limitations of Claims 1 and 9 because "the metadata in Davis is a meaningless output of a hash function, which may be used as a watermark, but, if applied to a browser, as allegedly disclosed in Levy, would be meaningless", and "such data cannot be used either for linking to another website or for controlling any other device" (Amendment, page 5).

However, this is not true, because a watermark, itself, is an identifier (more commonly used to ensure that illegal copies of media are not distributed). A hash is not meaningless data if it is used to identify a signal. Once a signal is identified, it can be used for other purposes. Even if Davis did not specifically state that the has is used to retrieve or control data, but is only used to generate an identification watermark, Levy does teach the use of this identification information [watermark] for other purposes once the media file is identified. Specifically, Levy teaches that the identifier is mapped and used to "get more information" pertaining to the watermarked and identified media file (col. 2, lines 38-61). More importantly, Davis teaches acting on the metadata such as allowing the user to access additional information stored locally or remotely, which directly corresponds to a browser's retrieval functionality especially when Davis mentions a URL as an example (col. 17, line 53 – col. 18, line 15). Therefore, applicant's statement that Davis's metadata is "useless" and "cannot be used either for linking to another website or for controlling of any other device" is not true.

More importantly, even if applicant's invention uses the metadata derived from an audio file "has specific meaning as to the parameters of the audio file and can be used as an output signal to control data useful for controlling devices such as lighting devices", lighting devices are not claimed. Davis specifically teaches that information, that may be stored remotely or locally, can be displayed to the user in response to analyzing metadata in an audio file. This is controlling whatever system/application the user is using to access the information based on the metadata in Davis. Therefore, it is also untrue that Davis's system, in combination with Levy, results in a "nonsensical

system which lacks any kind of utility". This part of both patents' functions, which are,

on a high-level, described above, are very typical of the inventions belonging to

Digimarc corporation (both patents are assigned to this assignee) and so it is very easily

inferred that the combination can be made.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-4, 8-10, are rejected under 35 U.S.C. 103(a) as being unpatentable

over Davis et al. (US 7,209,571), hereafter Davis, in view of Levy et al. (US 6,505,160),

hereafter Levy.

        As per Claim 1, Davis teaches a method of processing an audio signal

comprising acts of receiving an audio signal, extracting musical features from the audio

signal, and translating the extracted features into metadata, the metadata comprising an

instruction set of a markup language ("metadata… sound file… average energy,

autocorrelation with set delay… computed and stored in metadata", col. 20, lines 49-64;

"voice data… music files", col. 19, lines 20-39; "encoding metadata into media signals",

col. 21, lines 10-37),

the metadata comprising an instruction set of a markup language ("metadata may be specified using... XML", col. 15, line 49 – col. 16, line 5; "display... to the user... remote... the hashed metadata may be used as a database key to look up", col. 17, line 53 – col. 18, line 15)

receiving markup language assets ("XML processor... provide access to their content and structure", col. 15, line 49 – col. 16, line 5; "display... to the user... remote... the hashed metadata may be used as a database key to look up", col. 17, line 53 – col. 18, line 15).

Davis fails to teach transmitting the instruction set to a browser, receiving markup language assets, and rendering the markup language assets in synchronization with the received audio signal, which is output.

Levy suggests transmitting the instruction set to a browser, receiving markup language assets, and rendering the markup language assets in synchronization with the received audio signal, which is output ("connect that signal with metadata", col. 2, lines 5-21; "identifier is associated with metadata... physical distribution... electronic distribution... copyright owner, sound recording owner... allows a fan of a particular type of music... get more information", col. 2, lines 38-61; "radio broadcasts... automatically... forwards the identifier to a server to look up the associated metadata or action", col. 9, lines 30-39; "playlist's database... station ID... object ID... mapping", col. 10, line 50 – col. 11, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Davis to include the teaching of Levy of transmitting the

instruction set to a browser, receiving markup language assets, and rendering the

markup language assets in synchronization with the received audio signal, which is

output, in order to provide information that someone with the audio signal may be

interested in, as described by Levy (col. 2, lines 38-61).

As per Claim 2, Davis teaches an act of storing the metadata ("metadata...

sound file... average energy, autocorrelation with set delay... computed and stored in

metadata", col. 20, lines 49-64).

As per Claim 3, Davis teaches storing the metadata with associated time data

("time or location stamps", col. 18, line 59 - col. 19, line 17).

As per Claim 8, Davis teaches wherein the musical features extracted from the

audio signal include one or more of tempo, key, and volume ("metadata... sound file...

average energy, autocorrelation with set delay... computed and stored in metadata",

col. 20, lines 49-64; where energy reflects volume).

As per Claims 9-10, their limitations are similar to those in Claim 1-2, and so are

rejected under similar rationale.

As per Claim 4, Davis suggests wherein the time data defines a start time and a

duration relative to the received audio signal, of each markup language term in the

instruction set ("time stamp varies… audio recording… metadata creation… supply the

time stamp to mark the time that the device or program processed the media signal, its

metadata, or the watermark in the media signal", col. 18, lines 42-52; where the multiple

time stamps for processing metadata and a watermark [where the watermark is also a

form of metadata] indicates a duration based on the difference in the marked times, and

the time stamps are related to the audio signal processed).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ERIC YEN whose telephone number is (571)272-4249.

The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EY 4/5/09

/Richemond Dorvil/
Supervisory Patent Examiner, Art Unit 2626